

Response to Office Action Mailed November 25, 2002

A. Claims in the Case

Claims 1-22 have been rejected. Claims 1-27 are pending. Claims 1, 9, and 22 have been amended. Claims 23-27 are new.

B. The Claims Are Not Unpatentable Under 35 U.S.C. § 101

The Examiner has rejected claims 16-22 under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter. Applicant respectfully disagrees with this rejection.

If a claim defines a useful machine or manufacture by identifying the physical structure of the machine or manufacture in terms of its hardware or hardware and software combination, it defines a statutory product. MPEP § 2106 IV B 2(a).

The Examiner states:

A carrier medium is not a machine or system as there is no specific recitation of machine or system components. A carrier medium is not recognized as a composition of matter. A carrier medium, per se, is merely a data structure.

The Examiner further states:

In particular, it is unclear whether the program instructions, as recited in claims 16-22, are embodied on a specific readable medium within the technological arts (and thus tangible). Such claimed instructions do not define any structural or functional interrelationships between the program instructions and carrier medium, which permit the purpose of the instructions to be realized (see MPEP section 2106 IV, B, 1, (a) for further guidance).

The Specification states:

Various embodiments further include receiving or storing instructions and/or data implemented in accordance with the description herein upon a carrier medium. Suitable carrier media include memory media or storage media such as magnetic or optical media, e.g., disk or CD-ROM, as well as transmission media or signals such as electrical, electromagnetic, or digital signals, conveyed via a communication medium such as network 55 and/or a wireless link.
(Specification, page 9, lines 11-16)

Thus, the Specification describes a carrier medium as memory media or storage media, both of which are computer hardware, and transmission media or signals.

Amended claim 16 describes a combination of features including:

A carrier medium comprising program instructions, wherein the program instructions are computer-executable to implement:

receiving insurance claim assessment data entered by a user in response to a plurality of insurance claim assessment questions during an insurance claim consultation session; and

sending the insurance claim assessment data across a network via one or more Internet protocols to an insurance claim processing server

wherein the program instructions comprise a sequence of steps established dynamically in real time.

Thus, claim 16 is a claim for a carrier medium (i.e., hardware) that includes program instructions (i.e., software component). Therefore, amended claim 16 and claims dependent thereon are patentable subject matter. Applicant respectfully requests removal of the 35 U.S.C. § 101 rejection of claim 16 and claims dependent thereon.

C. The Claims Are Not Anticipated by Borghesi Under 35 U.S.C. § 102(e)

The Examiner has rejected claims 1-2, 6-7, 9-10, 12-14, 16-17, and 19-21 as being anticipated by U.S. Patent 5,950,169 to Borghesi et al. (hereinafter "Borghesi") under 35 U.S.C. § 102(e). Applicant respectfully disagrees with this rejection.

The standard for “anticipation” is one of strict identity. A claim can only be anticipated if each and every element set forth in the claims is found to be either expressly or inherently described in the cited art. *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 728, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987), MPEP § 2131.

Amended claim 1 describes a combination of features including but not limited to: “wherein the first set of program instructions comprises a sequence of steps established dynamically in real time” and “wherein the second set of program instructions comprises a sequence of steps established dynamically in real time.” Amended claim 9 describes a combination of features including but not limited to: “wherein receiving and sending comprise a sequence of steps established dynamically in real time.” Amended claim 16 describes a combination of features including but not limited to: “wherein the program instructions comprise a sequence of steps established dynamically in real time.”

Support for the above-mentioned features is found in the Specification. The Specification states:

As used herein, an IC insurance claim processing system includes a series of instructions executed by a computer system 70 and/or 80 for processing an IC’s business transactions. A claim processing system may include one or more processing tasks. A processing task may include a sequence of one or more processing steps or an ordered list or a structured list of one or more processing steps... In another embodiment the sequence of steps may be established dynamically, in real-time.
(Specification, page 12, lines 9-14)

In one embodiment, during the processing of an insurance claim, a business rule and/or an IC system user input may determine that the insurance claim processing needs the execution of additional steps or tasks to continue the processing of the claim. The IC system user may provide inputs to the insurance claims processing server software 60 at any display screen associated with a step included in a Table of Contents. The insurance claim processing software may dynamically modify the number of steps and/or the sequence of their execution to complete the claim processing transaction. An IC system user working at a client system 20b may then iterate through the claim processing steps and arrive at an estimated value for the insurance claim.
(Specification, page 13, lines 21-29)

Borghesi states:

A system and method for managing and processing insurance claims is provided that implements an object oriented graphic user interface. The system includes at least one remote computer for entering and viewing insurance claim information. A wide area network capable of communicating with the remote computer and a computer in communication with said wide area network are also included. An insurance datafile, generated at said remote computer, is transferrable over the network. The method includes the steps of transmitting a claim assignment from an insurance office computer to a mailbox in a communications server, retrieving the assignment at a remote computer and generating an insurance claim datafile containing all data pertinent to an insurance claim and allowing for bidirectional transmission of the datafile over a wide area network. A graphic user interface for use in managing an insurance claim from an initial claim to final settlement is also included. The interface has common workflow objects such as an in box, an in process box, and an out box, for managing and manipulating one or more workfiles.
(Borghesi, Abstract)

Borghesi does not appear to teach or suggest such combination of features of amended claim 1, including but not limited to the features of “wherein the first set of program instructions comprises a sequence of steps established dynamically in real time” and “wherein the second set of program instructions comprises a sequence of steps established dynamically in real time.” Applicant respectfully requests removal of the rejection of claim 1.

Borghesi does not appear to teach or suggest such combination of features of amended claim 9, including but not limited to the features of “wherein receiving and sending comprise a sequence of steps established dynamically in real time.” Applicant respectfully requests removal of the rejection of claim 9.

Borghesi does not appear to teach or suggest such combination of features of amended claim 16, including but not limited to the features of “wherein the program instructions comprise a sequence of steps established dynamically in real time.” Applicant respectfully requests removal of the rejection of claim 16.

D. The Claims Are Not Obvious Over Borghesi in View of McKee and Walker Under 35 U.S.C. § 103(a)

The Examiner has rejected claims 3 and 4 as being obvious over Borghesi, as applied to claim 1, in view of U.S. Patent Application No. 6,272,482 to McKee et al. (hereinafter “McKee”) and U.S. Patent Application No. 6,119,093 to Walker et al. (hereinafter “Walker”) under 35 U.S.C. § 103(a). Applicant respectfully disagrees with these rejections.

In order to reject a claim as obvious, the Examiner has the burden of establishing a *prima facie* case of obviousness. *In re Warner* et al., 379 F.2d 1011, 154 U.S.P.Q. 173, 177-178 (C.C.P.A. 1967). To establish a *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974), MPEP § 2143.03.

If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988), MPEP § 2143.03.

As mentioned in Section C, the combination of features of amended claim 1 does not appear to be taught or suggested by Borghesi. Therefore, the combination of features of claims 3 and 4, in combination with the features of claim 1, do not appear to be taught or suggested by the cited art. Applicant respectfully requests removal of the rejection of claims 3 and 4.

E. The Claims Are Not Obvious Over Borghesi Under 35 U.S.C. 103(a)

The Examiner has rejected claims 5, 8, 11, 15, 18, and 22 as being obvious over Borghesi under 35 U.S.C. § 103(a). Applicant respectfully disagrees with these rejections.

For at least the reasons stated above, the combination of features of amended claim 1 do not appear to be taught or suggested by Borghesi. Therefore, the features of claims 5 and 8, in combination with the features of claim 1, do not appear to be taught or suggested by the cited art. Applicant respectfully requests removal of the rejection of claims 5 and 8.

For at least the reasons stated above, the combination of features of amended claim 9 do not appear to be taught or suggested by Borghesi. Therefore, the features of claims 11 and 15, in combination with the features of claim 1, do not appear to be taught or suggested by the cited art. Applicant respectfully requests removal of the rejection of claims 11 and 15.

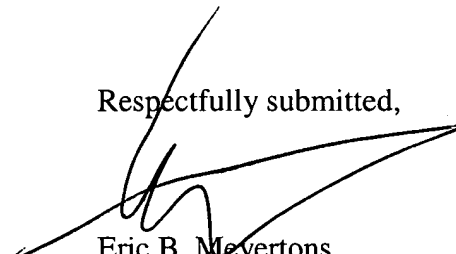
For at least the reasons stated above, the combination of features of amended claim 16 do not appear to be taught or suggested by Borghesi. Therefore, the features of claims 18 and 22, in combination with the features of claim 16, do not appear to be taught or suggested by the cited art. Applicant respectfully requests removal of the rejection of claims 18 and 22.

F. Summary

Based on the above, Applicant submits that all of the claims are now in condition for allowance. Favorable reconsideration is respectfully requested.

Applicant respectfully requests a one-month extension of time to respond to the Office Action dated November 25, 2002. A fee authorization form in the amount of \$284.00 is enclosed for the extension of time fee and added claims fee. If any further extension of time is required, Applicant hereby requests the appropriate extension of time. If any fees are inadvertently omitted or if any additional fees are required or have been overpaid, please appropriately charge or credit those fees to Meyertons, Hood, Kivlin, Kowert & Goetzel Deposit Account No. 50-1505/5053-36000/EBM

Respectfully submitted,



Eric B. Meyertons
Reg. No. 34,876

Attorney for Applicant (s)

MEYERTONS, HOOD, KIVLIN, KOWERT & GOETZEL, P.C.
P.O. BOX 398
AUSTIN, TX 78767-0398
(512) 853-8800 (voice)
(512) 853-8801 (facsimile)

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